

Remarks

Introduction

Claims 48 to 113 were previously pending in this application. With this amendment, claims 48 to 113 have been cancelled, and claims 114 to 171 have been added. No new subject matter has been introduced with these amendments.

Specifically, in light of the Examiner's rejection of the previous amended claims due to the absence of a reference to "a hydrophilic polymeric material and a water soluble polymer" in the contact lens composition, Applicant has reinserted the a portion of the originally pending claim set and an amended version of previously pending claim 48 and its dependent claims 49 to 62. Original claim 18 has been rewritten as new claim 114; original claim 26 has been rewritten as new claim 119; original claim 28 has been rewritten as claim 120; original claim 30 has been rewritten as claim 121; and original claim 33 has been rewritten as claim 126. Applicant has removed any reference to previously pending claims 63 to 113 in light of the Examiner's determination that these claims would be subject to a further restriction requirement.

In view of the above, claims 114-171 are currently pending, and each of the present claims is within the scope of the originally filed claims.

Applicant respectfully requests entry of this Amendment and reconsideration of the rejections.

Rejection Under 35 U.S.C. § 112, first paragraph

Claims 4, 7, 10, 19, 22, 24, and 27 have been rejected under 35 U.S.C. § 112, first paragraph as allegedly not complying with the enablement requirement.

Claims 4, 7, and 10 have been cancelled without prejudice. Therefore, the rejection as it relates to claims 4, 7, and 10 is moot.

The subject matter of original claims 19, 22, and 24 has been reinserted as new claims 115, 117, and 118, respectively. Applicant addresses the rejections of claims 19, 22, and 24 as they would apply to claims 115, 117, and 118.

Claim 19, now claim 115, was rejected for including the language "the container is structured to hold the contact lens" because no structure was recited. Applicant has presented claim 115 to recite that the container has a "cavity" that holds the contact lens. Figure 1, clearly

shows the structure of one exemplary embodiment of such a cavity thereby obviating this rejection.

Original claim 22, now claim 117, was rejected for the use of the phrase "the water soluble polymer component in the contact lens is derived from a diluent material." Applicant has present claim 117 without the objected language, thereby obviating this rejection.

Original claim 24, now claim 118, was rejected for the use of the phrase "the contact lens body has an increased modulus relative to an identical lens body in which the water soluble polymer component is replace with water." Applicant has presented claim 118 without the objected language, thereby obviating this rejection.

In view of the above, applicant submits that the rejection under 35 U.S.C. § 112, first paragraph cannot be properly maintained and requests that the rejection be withdrawn.

Rejection Under 35 U.S.C. § 112, second paragraph

Claims 4, 7, 10, 16, 19, 22, 24, 27, 32, 34-36, 38, 40, and 42-45 have been rejected under 35 U.S.C. § 112, second paragraph as allegedly being indefinite.

Claims 4, 7, 10, 16, 34-36, 38, 40, and 42-45 have been cancelled without prejudice. Therefore, the rejection as it relates to claims 4, 7, 10, 16, 34-36, 38, 40, and 42-45 is moot.

The subject matter of original claims 19, 22, 24, 27, and 32 has been reinserted as new claims 115, 117, 118, and 122-125, respectively. Applicant addresses the rejections of claims 19, 22, 24, 27, and 32 as they would apply to claims 115, 117, 118, and 122-125.

Claim 19, now claim 115, was rejected for including the language "the container is structured to hold the contact lens" because no structure was recited. Applicant has presented claim 115 to recite that the container has a "cavity" that holds the contact lens. Figure 1, clearly shows the structure of one exemplary embodiment of such a cavity thereby obviating this rejection.

Original claim 22, now claim 117, was rejected for the use of the phrase "the water soluble polymer component in the contact lens is derived from a diluent material." Applicant has present claim 117 without the objected language, thereby obviating this rejection.

Original claim 24, now claim 118, was rejected for the use of the phrase "the contact lens body has an increased modulus relative to an identical lens body in which the water soluble

polymer component is replace with water." Applicant has presented claim 118 without the objected language, thereby obviating this rejection.

Original claim 32, now split between claims 122 and 125, was rejected for recitation of "such as" and "the like" within the claimed group. Applicant has presented claim 32 as claims 122 to 125 without the objected terms, and has split the group across four new claims thereby more clearly reciting the scope of the protection being sought.

In view of the above, applicant submits that the rejection under 35 U.S.C. § 112, second paragraph cannot be properly maintained and requests that the rejection be withdrawn.

Rejections Under 35 U.S.C. § 102

Claims 1-4, 6, 7, 10, 11, 14, 16-19, 22, 24, 26-28, 30, 32-36, 38, 40, and 42-45 have been rejected under 35 U.S.C. § 102(b) as being anticipated by Hu (US 20010044482), by Gordon (US 4,123,408), or by Shah (US 4,462,665). Claims 1-3, 10, 16-19, and 27 have been rejected under 35 U.S.C. § 102(b) as being anticipated by Tanaka (US 6,008,170), or Salpekar (US 6,440,366).

Applicant does not concede to the correctness of the rejections. However, to advance the prosecution of the present application, the previously pending claims have been cancelled without prejudice, and new claims 114-171 have been added. As indicated herein, the subject matter of original claims 18-32 closely corresponds to the subject matter of new claims 114-126. Applicant traverses each the rejections as each relates to the present claims, and submits that the rejections cannot be properly maintained.

MPEP § 2131 provides that "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). ... "The identical invention must be shown in as complete detail as is contained in the ... claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). The elements must be arranged as required by the claim *In re Bond*, 910 F.2d 831, 15 USPQ2d 1566 (Fed. Cir. 1990).

None of the references, Hu, Gordon, Shaw, or Tanaka, specifically describe any package systems or sealed packages that comprise a contact lens and a liquid medium, let alone such package systems that comprise a contact lens that comprises a hydrophilic polymeric material

and a water soluble polymer component, and a liquid comprising an additional amount of the water soluble polymer component that is present in the contact lens. Therefore, a rejection of claims 114-171 over Hu, Gordon, Shaw, or Tanaka cannot be properly maintained and should be withdrawn.

Salpekar does not describe a contact lens comprising a hydrophilic polymeric material and a water soluble polymer component, and a packaging liquid comprising an additional or different amount of the water soluble polymer component present in the contact lens. In short, Salpekar does not describe any package that includes the same water soluble polymer material present in the contact lens and in the packaging liquid. Therefore, a rejection of claims 114-171 over Salpekar cannot be properly maintained and should be withdrawn.

In view of the above, applicant submits that the rejections, as applied to the newly added claims, are unsupported by the cited references and should be withdrawn.

Conclusion

In view of the foregoing amendments and remarks, Applicant submits that the present claims, that is claims 114-171, are in condition for allowance. Notice of which is respectfully requested. If a telephone interview would be of assistance in advancing prosecution of the subject application, Applicant's undersigned representative invites the Examiner to telephone him at the number provided below.

Although no additional fee should be necessary, the Commissioner is hereby authorized to charge any additional fees deemed necessary, or credit any overpayment, to Deposit Account No. 50-4064. Please show the docket number of this application with any charge or credit to the Deposit Account.

Respectfully submitted,

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